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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,619	12/20/2001	Toshio Suzuki	2001_1875A	1217

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EXAMINER

SAUCIER, SANDRA E

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 01/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/022,619

Applicant(s)
Suzuki et al.

Examiner
Sandra Saucier

Art Unit
1651



– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3,4
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claims 1-5 are pending and are considered on the merits.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 6 and 9 of copending Application No. 09/892743. Although the conflicting claims are not identical, they are not patentably distinct from each other because a microbe from genus *Alcaligenes* of strain FERM BP-3098 is employed in the same reaction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections – 35 USC § 112

INDEFINITE

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "which is characterized in". This term is indefinite because

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it cannot be determined if these are the only characteristics or if the claim is open to other characteristics. It is suggested that "comprising" be substituted for this phrase.

DEPOSIT

Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

At least some of the claims require one of ordinary skill in the art to have access to a specific microorganism. Because the microorganism is essential to the claimed invention, it must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. If the microorganism is not so obtainable or available, the requirements of 35 USC 112 may be satisfied by deposit of the microorganism. The specification does not disclose a repeatable process to obtain the microorganism and it is not clear from the specification or record that the microorganism is readily available to the public.

Since the deposit has been made under the terms of the Budapest Treaty, then an affidavit or declaration by applicants or a statement by an attorney of record over his/her signature and registration number, stating that all restrictions imposed by the depositor on availability to the public of the deposited material will be irrevocably removed upon issuance of the patent would satisfy the deposit requirement. See 37 CFR 1.808.

Assurance may be provided in the form of an affidavit, declaration or averment under oath or by a statement of the attorney of record over her or his signature and registration number.

The specification must also state the date of deposit, the number granted by the depository and the name and address of the depository. See 37 CFR 1.803-1.809 for additional explanation of these requirements.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action: A person shall be entitled to a patent unless (a) the invention was known or used by

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others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent, (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 6-209781 [IDS] or JP 6-030790 [IDS].

The claims are directed to a method of producing (R)-1,2-propanediol by assimilating the unwanted enantiomer from a racemic mixture using a microbe from the genus *Pseudomonas* or *Alcaligenes*. Claim 5 is directed to a specific strain of *Pseudomonas nitroreducens*.

The references are relied upon as explained below.

JP 6-209781 discloses a method of using *Pseudomonas* TRB2, TRB4, TRB13 to enantioselectively produce R-1,2-propanediol from the raceme. See abstract where R=H and m=1.

JP 6-030790 disclose a method of using *Pseudomonas* TRB2, TRB4, TRB13 to enantioselectively assimilate the (S)-1,2-propanediol enantiomer from its raceme.

Since the reference does not describe the species of *Pseudomonas* used in the process, but rather refers to them as TRB2, etc., it is unclear what strain these microbes may be and it is reasonable assumption that they may be the same strain as presently in the claims.

Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by US 5,246,843 [IDS].

Claim 5 is directed to a specific strain of *Pseudomonas nitroreducens*.

US 5,246,843 discloses *Pseudomonas* FERM P-11109, 11108, 11110 which is capable of producing R-3-halo-1,2-propanediol from the raceme. Although the species of the disclosed *Pseudomonas* is not revealed by the patent, it is a reasonable assumption that they may be the same strain as presently claimed because they belong to the same genus and perform an analogous enantioselective assimilation.


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The Patent and Trademark Office is not equipped to conduct experimentation in order to determine whether or not applicants' strain differs and, if so, to what extent from the strains discussed in the references. Accordingly, it has been established that the prior art strains, which have the same genus classification and share the property of being able to produce assimilate (R)-1,2-propanediol from the raceme, demonstrate a reasonable probability that it is either identical or sufficiently similar that whatever differences exist are not patentably significant. Therefore, the burden of establishing novelty or unobviousness by objective evidence is shifted to applicants.

Merely because a characteristic of a known strain is not disclosed in a reference does not make the known strain patentable. The known strain possesses inherent characteristics which might not be displayed in the tests used the reference. However, the microbe disclosed may be the same microbe as claimed. Clear evidence that the strains of the cited prior art do not possess a critical characteristic that is possessed by the claimed strain, would advance prosecution and might permit allowance of claims to applicants' strain.

To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1651. The supervisor for 1651 is M. Wityshyn, (703) 308-4743. The normal work schedule for Examiner Saucier is 8:30AM to 5:00 PM Monday and Tuesday and 8:30 AM to noon on Wednesday.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Saucier whose telephone number is (703) 308-1084. Status inquiries must be directed to the Customer Service Desk at (703) 308-0197 or (703)-308-0198. The number of the Fax Center for the faxing of official papers is (703) 872-9306 or for after finals (703) 872-9307.



Sandra Saucier
Primary Examiner
Art Unit 1651
January 8, 2003